

REMARKS

All pending claims in the present application have been finally rejected in the Office Action of August 2, 2005 (the Office Action). Claims 39-50 have been rejected under the judicially created doctrine of obviousness type double patenting over claims 32-47 of co-pending Application No. 09/558,922, and rejected under 35 U.S.C. §103(a) as being unpatentable in view of Dasan, U.S. Patent 5,761,662, and further in view of Huang et al. (Huang), U.S. Patent Application Publication No. US 2002/0091697. New claims 51-67 have been added herein. For the reasons specified herein and below, applicant respectfully requests reconsideration and removal of the rejections, consideration of newly presented claims 51-67, and timely allowance of this application.

Non-art Rejection – Provisional Double Patenting

Claims 39-50 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-47 of copending Application No. 09/558,922. Applicant respectfully traverses this rejection. Applicant asserts that the method of delivering to, and coordinating the operation of software components on a user's computer, which are authored in a web-based computer language yet operate to display content outside of a web browser application (to thereby allow a content provider to side-step the constraints on presentation of the content imposed by traditional web browser user interfaces) would not be obvious to one of ordinary skill in the art in light of the disclosure directed to managing a server capable of providing Internet content and functionality to a user of a computing device as disclosed in Application No. 09/558,922. However, as the rejection is provisional, and at the present time neither this case nor Application No. 09/558,922 have been

afforded an indication of allowance, Applicant reserves leave for filing additional arguments and actions for a future date.

Rejections from the Office Action of 08/02/2005 - 35 USC §103

Previously presented claims 39-50 were rejected in an Office Action dated 08/02/2005 (hereafter the Office Action) under 35 USC §103(a) as being unpatentable in view of Dasan, U.S. Patent 5,761,662, and further in view of Huang et al. (Huang), U.S. Patent Application Publication No. US 2002/0091697. At the outset of this response, applicant offers a discussion of the general teachings of the present application and the cited references. Following this, a more specific discussion is presented, highlighting where specific claim limitations differ from Dasan and Huang.

The present invention is directed to a method and system for providing certain Internet (or web) content and functionality to a user in a user interface (frame) at the user's workstation. Importantly, while the content is of a form which may be viewed by a web browser application, instead according to the present invention the content is caused to be displayed in the user interface outside of and separate from a web browser application.

One goal of the present invention is to allow a content provider to side-step the constraints on presentation of the content imposed by traditional web browser user interfaces, such as the "page" metaphor, limited controls, serial display of information, etc. Accordingly, the present invention provides a system to which content providers can deliver customized user interfaces for the presentation of their web content, which are in turn delivered to end users with controls and functionality required to display the content in the customized user interfaces. (See also the remarks provided in applicant's Response to Office Action, submitted on August 23, 2004, for an additional summary of the present invention.) Two important concepts merit

highlighting here: (1) the author of the interfaces can specify client-resident functionality and appearance appropriate for specific web-delivered content, without concern for being constrained to display the content within the frame and control of a typical web browser user interface; and (2) an end user is provided with a list of such interfaces and can select which such interfaces are to be downloaded to his computer, the system according to the present invention managing all aspects of collecting, assembling for selection, and delivering the selected interfaces.

The nature of the user interface (its look and feel, its size, its location, its controls, its functionality, etc.) is specified to the user by way of a definition, and is a function of the type of content being provided. The definition also includes a software component (or process) which operates on content in some way. The customized user interface in which the content is displayed, together with the controls and other functionality associated with that interface, are referred to as a networked information monitor or NIM, in the specification. The user interfaces operating on a user's computing device are operated in conjunction with a manager for such interfaces, which is itself a program (or process) executed on the computing device.

As a simplified example, an object's user interface may appear as a map for displaying current local weather, represented as a dedicated frame on a computer desktop in the image of a small map for indicating the current local weather, the definition being computer programming code for rendering same and its controls (e.g., selecting a location) on the user's desktop, the functionality may be programming code which operates to obtain the current local weather for display and cause the display of the current local weather, and the content may be the current local weather obtained, for example, from a designated website. Generic controls for the user interface are also provided, such as a close button, options button, settings, etc.

Since the look and feel of the user interface is dictated by the nature of the content, providers of content ideally provide the definition of the user interface. Accordingly, the look and feel of the user interfaces for various interfaces vary from content to content. Optionally, there may be common attributes to the various user interfaces provided by content providers, as might be determined by a distributor of objects, such as branding. But such commonality does not hide the uniqueness of the user interfaces specific to the content they are designed to display.

Finally, the user interfaces and associated functionality may be provided from a centralized source or server, which manages their attributes, maintains their most current versions, and is able to add content and additional user interfaces. Communications with the server involve a user transmitting a user profile, so that the server is able to determine which interfaces the user has previously selected, determine whether updated interfaces are available, and deliver any such updated interfaces and possibly additional interfaces and content to the user. For example, a user may log into a such a server, and in response be provided with some or all of: updated look and feel for previously requested interfaces, newly requested interfaces, a list of suggested interfaces based on the user's profile, a new or updated managing process, and additional content such as advertisements or the like.

This is in stark contrast to the teachings of the references cited in the Office Action. Dasan teaches a method and structure for generating a personal newspaper. According to Dasan, a user establishes a profile, which is a list of topics of interest, and a list of web sites at which to look for the topics of interest. The system examines those sites for items containing the identified topics of interest, then presents those items for display in the user's browser window. The code and the process performed by the code are resident on a server (as

opposed to the user's computer). Profile editing options and results are displayed on the user's computer.

Huang discloses the design and functioning of a virtual desktop. A user may create a desktop on a remote computer, which may be accessed by communications via the Internet. The user is then able to access the remote computer and send commands that are processed by the remote computer. The results of such commands are the opening of folders to display either additional folders or documents, or the opening of documents, each within a browser window.

While these broad statements of the functioning of the present invention and the cited references help us understand how the invention and references are conceptually distinct, it is axiomatic that patentable differences must be based in the language of the claims. Accordingly, following is a discussion of the specific rejections, and how and where the language found in the claims of the present application differ from that found in the cited references.

Claims 39 -50

Claims 39 through 50 have been cancelled in the present application. Accordingly, they are not further discussed herein.

New claims 51-67

Applicant has added new claims 51 through 67 herein. Support for these claims may be found throughout the application as filed. While these claims are not currently rejected, applicant offers the following analysis of these claims in light of *Dasan* and *Huang* in order to address any potential issues presented by those references.

Initially, note that claim 51 (and claims 52 through 56 which depend therefrom) contains the limitation that information is assembled at a user's request containing "instructions usable by the computing device to present a frame, with associated controls, specifically designed to display certain web content outside of a window of a web browser program" (claim 51, lines 5-7). Applicant asserts that neither Dasan nor Huang, alone or in combination, teach, suggest or disclose these features.

Dasan specifically displays all data within browser windows (e.g., col. 3, lines 62-64), as opposed to within "a frame ... outside of a window of a web browser." Dasan also performs all functions as server-resident processes (e.g., col. 4, lines 42-44), as opposed to "instructions usable by the computing device to present a frame."

Likewise, all windows opened according to the Huang teachings are browser windows (e.g., paragraph 54, lines 3-7), and all functions are server-resident processes (e.g., paragraph 49). It is also worth noting that since a window (e.g., window 436) according to the teachings of Huang is opened simply by clicking on a URL link, that window is an instance of a browser window (albeit, with the navigation and other controls hidden). Thus, the assertion in the Office Action that window 436 is not a browser window is not technically accurate. Also, since the user interface of Huang is defined by a browser, which is designed to display virtually any web-based content, it is not "a frame, with associated controls, specifically designed to display certain web content..." (claim 1, lines 5-7).

Furthermore, new claim 52 recites that the information retrieved and transmitted to the user includes "instructions for invoking a first process, resident on said computing device when invoked, the results of which being capable of display within the frame" (claim 42, lines 2-3). Neither Dasan nor Huang teach, suggest or disclose such a feature.

New claim 53 recites that the information retrieved and transmitted to the user includes a functionality and an appearance of the frame within which said certain web content may be presented" (claim 53, lines 2-3). According to Dasan, news items are retrieved from specified websites, and aggregated, filtered, and formatted, before being provided to the user. Despite the lengthy sections cited in the Office Action, there is no mention therein of providing a user with the web content together with a definition for the functionality and appearance of the frame in which the content is presented.

Conceptually, the present invention allows a content provider to display content in a customized frame on the user's computer. Each frame may appear as a unique object on a user's desktop (e.g., a clock, a weather map, a ticket kiosk, a jukebox, etc.) with content coordinated with the look and feel of the object (e.g., time, local weather, ticket sales, music selections, etc., respectively). Thus, the functionality and appearance of the frame is specifically designed to display certain web content (claims 51 and 53). However, the system of Dasan converts the retrieved news items into ASCII files (col. 8, lines 8-11), thus dissociating the content text from the format which the content provider originally intended to be associate with that content. Dasan then aggregates the ASCII text from various such content providers into a single file, and applies its own formatting prior to delivering the newly-formatted content ("personalized newspaper") to the user. Importantly, in the process of producing the personalized newspaper, the system of Dasan substitutes its own format for that specifically designed for the particular content, and accordingly teaches away from providing a definition of a user interface specifically designed for content to be displayed therein. Huang adds no additional disclosure related to providing functionality and appearance of a frame specific to the content which is to displayed. Therefore, the references fail to teach, disclose or suggest, alone or in combination, the invention claimed in claim 53.

As mentioned, each of the various frames may have unique attributes of their appearance and functionality, as claimed in claim 54. Furthermore, each frame may have certain commonalities in appearance and functionality (e.g., a close button, resizing handles, etc.), as claimed in claim 55. Furthermore, the present invention is particularly unique in that it permits the simultaneous viewing of a number of frames containing different web-content. For example, a user may simultaneously have open a clock, a weather map, and a jukebox, each displaying web content. In order to coordinate the operation of multiple frames, a manager program may be retrieved and transmitted to the user's computer device. Neither Dasan nor Huang disclose any details about such features, let alone retrieving code capable of enabling them and transmitting that code to a user's computer. Accordingly, neither Dasan nor Huang teach, suggest or disclose the invention claimed in claims 51-56.

Claim 57 recites storing a user profile which includes "a list of networked information monitors" (claim 57, lines 4-5). A networked information monitor is defined in the specification as "a fully configurable frame with one or more controls; the frame through which content is optionally presented" (page 7, lines 22-23). "These fully configurable frames stand in contrast to present web browsers, which are branded by the browser vendor and which have limited means by which to alter the controls associated with the browser." (Specification, page 7, lines 23-26.) Neither Dasan nor Huang et al. teach, suggest, nor disclose, alone or in combination, configurable frames, such configurable frames with one or more controls, nor such frames through which content is optionally presented.

In addition, claim 57 recites a first software component executable on the user's computer with listed networked information monitors identified in said first software component. In one embodiment, the first software component may be a managing program coordinating the

operation of various networked information monitors. Both Dasan and Huang are silent as to any such first software component in which networked information monitors are identified.

Claim 58 depends from and contains all of the of the limitations of claim 57. For the reasons explained with regard to claim 57, claim 58 is also distinguished from Dasan and Huang. Furthermore, claim 58 provides for a mechanism for determining whether "each of the networked information monitors transmitted therewith are updated versions of corresponding networked information monitors previously stored on the user's computing device, and if so replacing the previously stored networked information monitors with updated networked information monitors" (claim 58, lines 2-6). Since Dasan and Huang are silent about any feature resembling a networked information monitor, they must also be silent as to the feature of determining whether the user has installed the most recent versions thereof.

Claim 59 also depends from and contains all of the of the limitations of claim 57. For the reasons explained with regard to claim 57, claim 59 is also distinguished from Dasan and Huang. Furthermore, claim 59 provides for the delivery of "data independent of the second software component and the definition" (claim 59, lines 3-4). Dasan displays only the data assembled from the various sources it is programmed to retrieve from, and Huang displays only the contents of the user's desktop. Thus, the references are silent as to the provision of such data.

Claims 60-64 depend from claim 57, and contains all of the of the limitations of that claim. Thus, for the reasons explained with regard to claim 57, claim 60-64 also distinguished from Dasan and Huang. And as to these claims, as has been previously stated, the references disclose no equivalent of the second software component. Thus, they do not teach the specific variants involving the second software component claimed in each claim.

Claim 65 recites “displaying on the computer device a menu of user selectable networked information monitors” (claim 65, lines 3-4). As previously explained, neither Dasan nor Huang teach, suggest or disclose networked information monitors. Thus, claim 65, and claims 66 and 67 which depend from claim 65, are distinguished from these references.

The combination of Dasan and Huang

The Office Action seeks to combine the teachings of Dasan and Huang in order to demonstrate the obviousness of the claims in the present application. Applicant asserts that making such a combination is improper. In establishing a *prima facie* case of obviousness relying on the combination of two references, the references must disclose a reason or motivation to combine their teachings to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991). Furthermore, it is not enough to show that there is some abstract motivation for combining references. Rather, a person of ordinary skill in the art must be provided some motivation by the references to combine their teachings in the particular manner claimed. In re Koltzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). “In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed*.” In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998)(emphasis added).

As previously discussed, the present invention is directed computer software objects which are operable on a user’s computer, which are authored in a web-based computer language, and which display content outside of a web browser application, to thereby allow a

content provider to side-step the constraints on presentation of the content imposed by traditional web browser user interfaces. In other words, the software objects are web-based applications designed to run separate and apart from a web browser application. The objects include functionality and appearance appropriate for specific content, without concern for being constrained to display the content within the frame of a web browser user interface. The claims of the present application are directed to different facets of this overall focus. Therefore, if the combination of the cited references is proper, they should suggest making such a combination with the goal to obtain such software objects, authored in a web-based computer language, yet display content outside of a web browser application, with functionality and appearance selectable for particular content they are designed to display.

However, a careful reading of the references does not lead to any such suggestion. In support of the combination, the Office Action makes these assertions:

- 1) Dasan and Huang are in the same field of endeavor, and
- 2) The virtual desktop disclosed by Huang is similar to Dasan's method for retrieving information based on a personalized newspaper.

In addition to identifying no suggestion in the references for how one might make the combination, or even motivation to do so, the assertions are in fact incorrect. Dasan is directed to the collection and display of news information from disparate web sites based on a user profile, while Huang is directed to a personal web page which can act as a virtual desktop for a user, so that the organization of the user's data is consistent regardless of which machine on which the user views the data. With all respect for the examiner, these fields of endeavor are not the same. Nor is a virtual desktop similar to the retrieval and display of news items from disparate web sites. While each may present information accessible by clicking on links, there

is where the similarity ends. The desktop of Huang is used to organize files and documents (including links) obtained or created by the user. The newspaper of Dasan autonomously obtains, removes format from, and organizes news items based on user entered preferences, then delivers them for display.

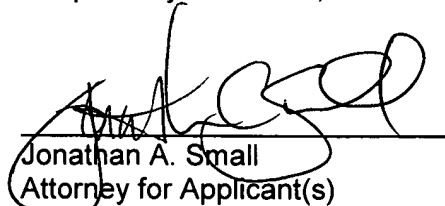
Accordingly, the references fail to provide any reason for making their combination, let alone how one skilled in the art might do so to obtain the claimed invention. Thus, applicant asserts that the proposed combination of the references is improper and cannot support a finding of prima facie obviousness of the claims of the present application.

CONCLUSION

In view of the foregoing, applicant believes all claims pending in this application now distinguish over the cited art and are in condition for allowance. The issuance of a formal Notice of Allowance of this application at the earliest possible date is respectfully requested.

If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jonathan A. Small', is written over a horizontal line.

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